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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/577,386	05/23/2000	Mark Lesswing	TZG0002	3851
93261	7590	03/29/2010	EXAMINER	
King & Spalding LLP (Trizetto Customer Number) 1700 Pennsylvania Avenue N.W. Suite 200 Washington, DC 20006			FRENEL, VANEL	
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1                   UNITED STATES PATENT AND TRADEMARK OFFICE

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4                   BEFORE THE BOARD OF PATENT APPEALS

5                   AND INTERFERENCES

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8                   *Ex parte* MARK LESSWING and DALE HOERLE

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11                   Appeal 2009-003775

12                   Application 09/577,386

13                   Technology Center 3600

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16                   Decided: March 29, 2010

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20                   *Before:* MURRIEL E. CRAWFORD, HUBERT C. LORIN, and BIBHU R.

21                   MOHANTY, *Administrative Patent Judges.*

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23                   CRAWFORD, *Administrative Patent Judge.*

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26                   DECISION ON REQUEST FOR REHEARING

1 INTRODUCTION

2 Appellants filed a Request for Reconsideration (filed November 23,  
3 2009, hereinafter “Request”) under 37 C.F.R. § 41.52 (2009) contending that  
4 the Board, in the Decision on Appeal (mailed November 10, 2009,  
5 hereinafter “Decision”) erred in affirming the rejection of claims 60 to 86  
6 under 35 U.S.C. § 103(a) (2002) as being unpatentable over Tarter (US  
7 5,704,044, patented Dec. 30, 1997) in view of Dart (US 6,529,876 B1,  
8 patented Mar. 4, 2003). Appellants hereby request that we reconsider and  
9 reverse the Examiner’s rejection of claims 60 to 86. In the Decision on  
10 Appeal the Board reversed the Examiner’s rejection of claims 1 to 11 and 24  
11 to 59 and affirmed the Examiner’s rejection of claims 60 to 86.

12 Appellants argue that we erred in holding that the Appellants did not  
13 rebut the Examiner’s case of obviousness. In our original Decision, we held  
14 that the Examiner met the initial burden of establishing a case of  
15 obviousness for the subject matter of claims 60 to 86 and thus the burden  
16 shifted to Appellants to rebut the case of obviousness (Decision 11 to 12).  
17 We further held that since the Appellants set forth only general assertions  
18 that the cited prior art did not disclose the subject matter of the claims, the  
19 Appellants did not meet that burden. As we said in our original Decision at  
20 page 12, the Appellants’ entire argument consisted of quoting aspects of the  
21 various claims without any discussion as to why the prior art does not render  
22 obvious the recitations in the claims.

23 In this request, the Appellants argue that they did identify what the  
24 references failed to teach or suggest and were under no obligation to discuss  
25 what the references disclose.

1           While the Appellants may not be under an obligation to discuss what  
2 the cited references disclose, Appellants did have a burden of establishing  
3 why the references failed to disclose the subject matter of the claims.

4           For example, in regard to claim 60, the Examiner in the Final  
5 Rejection found that the various recitations in the claim were disclosed in  
6 Tarter at column 1, lines 19 to 67, column 2, line 67, column 13, lines 44 to  
7 67, column 14, line 65 and in Dart, column 19, lines 1 to 18 and column 20,  
8 lines 6 to 68. The Examiner made reference to these portions of Tarter and  
9 Dart with reference to the individual recitations in the claim (Final Rej. 22 to  
10 23).

11           The Appellants did not discuss the specific portions relied on by the  
12 Examiner in the Tarter and Dart references. The Appellants did not discuss  
13 *any* portions of the Tarter and Dart disclosures. Appellants' total argument  
14 in the Appeal Brief was:

15                   Independent claim 60 recites, in part,  
16 "associating, with said at least one term,  
17 information, stored to computer-readable medium,  
18 representing at least one qualifier having a  
19 corresponding calculation method, wherein the at  
20 least one qualifier identifies at least one condition  
21 to be satisfied by a claim for reimbursement in  
22 order to trigger the corresponding calculation  
23 method." The applied combination of *Tarter* and  
24 *Dart* fails to teach or suggest at least this element  
25 of claim 60.

26                   Therefore, Appellant[s] respectfully  
27 request[] that this rejection of claim 60 be  
28 overturned.

29 (App. Br. 34).

1        This statement by the Appellants in the Brief, and the similar  
2 statements in the Brief regarding claims 61 to 86 amounts to quoting an  
3 aspect of claim 60 along with a general assertion that the cited references fail  
4 to teach this element of claim 60 and is not sufficient to rebut the  
5 Examiner's case of obviousness.

6        For the first time in this Request, the Appellants argue that the  
7 Examiner's rejection fails to provide a sufficient reasoning in support of the  
8 rejection because the Examiner did not provide a discussion as to why the  
9 referenced portions of the references relied on disclosed the recitations in the  
10 claims. This is an argument that the Appellants could have made in the  
11 Brief to rebut the Examiner's rejection. The Appellants did not make this  
12 argument. As such, we will not address this argument at this point.

13       The Appellants also argue that they had no burden to discuss what the  
14 references disclose in order to rebut the Examiner's case of obviousness. It  
15 is not that the Appellants had a burden to discuss what the references  
16 disclose but rather, it was necessary for the Appellants to explain why the  
17 rejection was in error to thereby rebut the Examiner's case of obviousness.  
18 While an argument that the references do not disclose an element of a claim  
19 may be considered an argument, the argument is not of sufficient weight to  
20 rebut the Examiner's case of obviousness.

21       While we have considered an elaborated on certain aspects of our  
22 original Decision in light of Appellants' request, we decline to modify our  
23 original Decision in any respect.

Appeal 2009-003775  
Application 09/577,386

1           No time period for taking any subsequent action in connection with  
2 this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.  
3 § 1.136(a)(1)(iv) (2007).

**DENIED**

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